

REMARKS

Applicants claim listing indicates that claims 1-27 are pending in the application, accordingly remarks are made with respect to claims 1-27. (The Official Action states that claims 1-29 are pending in the application.) Claims 1-27 are pending, claims 1, 7, 17, 23, 26 and 27 being independent. Claims 1-27 stand rejected under 35 USC 251.

All of the independent claims have been amended a second time to correct a clerical error: [H.sub.3 PO.sub.4] H₃PO₄.

New claims 28 - 30 have been added having additional features recited with respect to hexavalent and trivalent chromium, support is found at page 6, lines 13-19. No new matter has been added. Remarks made herein are based on the claims as amended hereby.

OATH/DECLARATION

The Patent Office stated that the reissue oath/declaration filed with this application is defective as not in compliance with the requirements of 37 CFR 1.175. The Patent Office also rejected claims 1-27 stating that they are based on a defective reissue declaration. In this reissue application, Applicants have added the additional feature of a surfactant to independent claims 1, 7 and 17. The surfactant was originally disclosed throughout the specification and in particular at page 7, line 12 et seq. The Patent Office has indicated that the Reissue Declaration filed with the application is defective asserting that the declaration fails to identify at least one error which is relied upon to support the reissue application.

The Examiner's attention is respectfully directed to the Supplemental Reissue Declaration, filed September 23, 2005, which Applicant respectfully submits provides additional information regarding the error relied upon to support the reissue application.

The declaration states:

An error in the patent arose out of an error during prosecution of the application which became the patent where Applicant's August 9, 2001 Amendment did not address all grounds of rejection in the April 9, 2001 Office Communication. This omission was not made of record by the Office and the patent was allowed. At least some of the claims of the patent are believed to be invalid due to the error.

Applicants respectfully submit that the foregoing statement identifies an error relied upon to support the reissue application that meets both 35 USC 251 and 37 CFR 1.175 and that the rejection should be withdrawn.

IMPROPER RECAPTURE

The Patent Office has rejected claims 23-27 under 35 USC 251 as being an improper recapture of surrendered subject matter. Applicants respectfully submit that the error identified in the Supplemental Reissue Declaration, filed September 23, 2005, obviates this recapture rejection where an actual mistake in considering and responding to the rejections of pending claims was made in the response to the April 9, 2001 Official Action.

The April 9, 2001 Official Action relied upon the following prior art in support of 102(b) and 103(a) rejections: USP 4749418; WO 91/05078; EP391442; WO97/21845; USP 4264378; WO96/07772; WO95/04169; WO95/25831; EP19430; UK2259920 and WO97/02369.

In responding to the April 9, 2001 Official Action, Applicants' representative did not expressly address: EP391442; WO97/21845; USP 4264378; WO96/07772; WO95/04169; WO95/25831; EP19430; UK2259920 and WO97/02369. These references were not argued or distinguished.

Applicants submit that this error in conduct of the prosecution resulted in several errors in the patent. First, the original claims were replaced with new claims having limitations that did not take into account patentability over all of the art relied upon by the Patent Office, resulting in errors in the patent by way of claims that are broader than those to which Applicants are entitled, see EP391442 and WO97/21845. Second, due to Applicants' representative overlooking a number of rejections in the April 9, 2001 Official Action and the Patent Office overlooking the lack of response to those rejections, claims that Applicant would otherwise have submitted for examination, as patentable over all of the rejections of April 9, 2001, were not submitted.

Applicants' representative could not and did not fully appreciate the patentable scope of the invention where all of the references cited in the Official Action of April 9, 2001 were not considered and addressed. Instead, Applicants' representative added limitations which would not have otherwise been considered by Applicant as distinguishing limitations. The facts bear this out. The issued claims of this patent are being amended to add a wholly separate component in order to establish patentability of the very claims submitted in response to the April 9, 2001 rejection. Certainly Applicants' representative did not purposefully submit claims having range limitations on hexavalent chromium and trivalent chromium known to be inadequate to obviate all rejections cited by the Patent Office.

It is clear from the prosecution history that all of the rejections were not addressed and, where the rejections were not addressed by Applicants in making their amendments, the scope of patentable claims was not recognized by Applicants or the Patent Office. As such, Applicants respectfully submit that the recapture rule does not apply. This rejection should be withdrawn.

New claims 28- 30 avoid the recapture rule where these reissue claims have been narrowed in other respects regarding components (C) and (D) and have different scope with respect to these limitations.

The Federal Circuit has provided three analytic steps for determining whether the recapture rule is avoided by reissue claims, stating: "We apply the recapture rule as a three-step process: (1) first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims; (2) next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and (3) finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule." N. Am. Container, Inc. v. Plastipak Packaging, Inc., 415 F.3d 1335, 1349 [75 USPQ2d 1545] (Fed. Cir. 2005) (citing Clement, 131 F.3d at 1471); see also Pannu, 258 F.3d at 1371 (citing Hester, 142 F.3d at 1482-83; Clement, 131 F.3d at 1470).

In new claims 28-30, the ranges of amounts of hexavalent and trivalent chromium are broader than those recited in claims of the issued patent. Notwithstanding the foregoing, in claims 28, 29 and 30 claim features relating to hexavalent and trivalent chromium are also narrower than what was claimed in the original patent claims, where these components have been provided with added limitations, such as for example the source of the components. These claims are also narrower than the original patent claims in that they contain the additional feature of the presence of (E) a surfactant. As such, even if the recapture rule is applicable to these claims, the rule is avoided by satisfaction of the third element of the Federal Circuit test where the same feature broadened has also been narrowed in these claims.

SN: 10/810,546
Art Unit: 1755

CONCLUSION

It is respectfully submitted that the independent claims as amended and their depending claims are patentable in view of the prior art of record. Applicant respectfully submits that this reissue application is in condition for allowance. Applicants respectfully request a telephonic interview with the Examiner to further prosecution in this matter. Any comments or questions regarding this amendment should be directed to the undersigned.

Respectfully submitted,
/Mary K. Cameron/

Mary K. Cameron
(Reg. No. 34,789)
Attorney for Applicants
248-589-4672

Henkel Corporation
Law Department
2200 Renaissance Boulevard, Suite 200
Gulph Mills, PA 19406